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| 09/942,171      | 08/30/2001  | Tsutomu Yamazaki     | 011350-285          | 6809             |

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EXAMINER

DESIRE, GREGORY M

ART UNIT

PAPER NUMBER

2625

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/942,171 ✓

Applicant(s)

YAMAZAKI, TSUTOMU

Examiner

Gregory M. Desire

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/30/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communication filed 1/18/05.

### ***Response to Amendment***

2. Applicant's arguments, see page 9 last paragraph, filed 1/18/05, with respect to the rejection(s) of claim(s) 1-14 under 35 USC 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Wang and Shirasaki.
3. The examiner acknowledges the amendment of claim 5. Therefore, 35 USC 112 second paragraphs have been withdrawn.

### ***Claim Objections***

4. Claim 17 is objected to because of the following informalities: There appears to be a typographical error in claim 17. Claim 17 is depending on claim 6. It appears it should depend on claim 16. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 12 is drawn to functional descriptive material not claimed as residing on a computer readable medium. MPEP 2106.IV.B.1

(a) (Functional descriptive Material) states:

“Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are not capable of causing functional change in the computer.”

“Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure’s functionality to be realized. “

Claim 12, while defining a program, does not define a “computer readable medium” and is thus non-statutory for that reason. A program can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on “computer readable medium” in order to make the claim statutory.

“In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure’s functionality to be realized, and is thus statutory.” MPEP 2106.IV.B.1 (a)

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 and 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al (5,774,579).

Regarding claims 1 and 12 Wang discloses

Receiving first document data and second document data obtained by reading respectively a first document and a second document (note fig. 4 block 416 in connection with col. 5 lines 5-6, multi page scanner reads multi pages which includes a first and second document) each having a non-text block and text block located in the vicinity of the non-text block fig. 10 (shows non-text located in the vicinity of text block)

Recognizing the text block form image data in the first document data and image data in the second document data (note col. 5 lines 55-59, text block is recognized and block selection is performed on the input documents).

Changing corresponding data in the first document data and the second document data so that the recognized text blocks do not overlap each other (note col. 5 line 60-67 and col. 2 lines 59-62, decomposing overlap blocks if they do overlap with text block, reads on changing corresponding data in documents so that text block do not overlap).

Printing an image based on the changed first and second document data (note col. 5 lines 10-11 and 35-60, printer outputs data from the computing equipment which performs the processing)

Wang does not disclose expressly block selection, wherein drawing number as text block and drawing as non-text block. Wang prior art discloses block selection of drawing number (note Wang fig. 1a shows character string fig. 1 and fig. 1b corresponding block selection 17a) and drawing (note fig. 1a, blocks 7, 8 and 9 and corresponding block selection fig. 1b 17, 18a and 19 and col. 2 lines 23-24, non-text line art as drawing). Wang and Wang prior art are combinable because they are from the same field of endeavor. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include drawing and drawing numbers in the block selection of Wang. The suggestion/motivation for doing so would have been separately grouping text and non-text data for further analysis (note col. 1 line 28-32). Therefore, it would have been obvious to combine Wang with Wang prior art to obtain the invention as specified in claim 1.

Regarding claims 2 and 13 Wang discloses,

Drawing numbers recognized in said step (b) includes those that are referenced in texts of the document (note Wang fig. 17a text block).

Regarding claims 3 and 14 Wang discloses,

Corresponding data of the first document data and the second document data are changed so that the recognized blocks become serial in said step (c) (note col. 5 lines 60-67).

Regarding method claim 4 Wang discloses

Receiving first document data and second document data obtained by reading respectively a first document and a second document (note fig. 4 block 416 in connection with col. 5 lines 5-6, multi page scanner reads multi pages which includes a first and second document) each having a text block printed fig. 10 (shows text block, 54, 55 and 56)

Recognizing the text block form image data in the first document data and image data in the second document data (note col. 5 lines 55-59, text block is recognized and block selection is performed on the input documents).

Changing corresponding data in the first document data and the second document data so that the recognized text blocks do not overlap each other (note col. 5 line 60-67 and col. 2 lines 59-62, decomposing overlap blocks if they do overlap with text block, reads on changing corresponding data in documents so that text block do not overlap).

Printing an image based on the changed first and second document data (note col. 5 lines 10-11 and 35-60, printer outputs data from the computing equipment which performs the processing)

Wang does not disclose expressly block selection, wherein page number as text block. Wang prior art discloses block selection of page number (note Wang fig. 1a shows character string page 1 and fig. 1b corresponding block selection 17a) and drawing (note fig. 1a, blocks 7, 8 and 9 and corresponding block selection fig. 1b the bottom block). Wang and Wang prior art are combinable because they are from the

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same field of endeavor. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include page number in the block selection of Wang. The suggestion/motivation for doing so would have been separately grouping text data for further analysis (note col. 1 line 28-32). Therefore, it would have been obvious to combine Wang with Wang prior art to obtain the invention as specified in claim 1.

Regarding method claim 5 Wang discloses,

Corresponding data of the first document data and the second document data are changed so that the recognized block becomes serial in said step (c) (note col. 5 lines 60-67).

### ***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 6-11 and 15-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Shirasaki et al (6,341,176).

Regarding apparatus claims 6 and 15 Shirasaki discloses,



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A receiving unit (note fig. 1 image inputting unit) for receiving first document image data and second document data obtained by reading respectively a first document and second document each having at least one drawing (examiner refers MPEP 2114).

An extraction means (note fig. 1, block 132, character extracting unit) for extracting a first caption group for identifying the drawing contained in the first document and a second caption group for identifying the drawing contained in the second document (examiner refers MPEP 2114).

A conversion means (note fig. 1 block 130, converting unit) for converting the first caption group and the second caption group into a third caption group so that a character string in the first caption group does not overlap a character string in the second caption group (examiner refers MPEP 2114).

Regarding apparatus claims 7 and 16 Shirasaki discloses,

Said conversion means further converts character strings contained in the first document and second document, which are identical to character strings that belong to the first caption group and the second caption group, into character strings that belong to the third caption group (claim refer to the conversion means of claim 6, thus examiner refers MPEP 2114)

Regarding apparatus claims 8 and 17 Shirasaki discloses,

Said extraction means recognizes a character string appended in the vicinity of the drawing as caption based on positional information of the drawing character string (claim refer to extraction means of claim 6, thus examiner refers MPEP 2114).

Regarding apparatus claims 9, 18 and 21 Shirasaki discloses,

A receiving unit (note fig. 1 image inputting unit) for receiving first document image data and second document data obtained by reading respectively a first document and second document each having at least one drawing (examiner refers MPEP 2114).

A recognizing means (note fig. 1, block 133, character recognizing unit) for recognizing drawing numbers from the first document image data and second document image data (examiner refers MPEP 2114).

A changing means (note fig. 1 block 130, converting unit) for changing corresponding data in the first document image data and the second document image data sot that the recognizing drawing numbers do not overlap each other (examiner refers MPEP 2114).

A printing unit (notes fig. 1 block 160 and col. 15 lines 54-55) for printing an image based on the changed first and second document data (examiner refers MPEP 2114).

Regarding apparatus claims 10 and 19 Shirasaki discloses,

Said recognizing means recognizes drawing numbers referenced in texts of the document (claim refer to recognizing means of claim 9, thus examiner refers MPEP 2114).

Regarding apparatus claims 11, 20 and 22 Shirasaki discloses,

Said changing means changes the corresponding data of the first document image data and the second document image data so that the recognized drawing numbers become serial (claim refer to the changing means of claim 9, thus examiner refers MPEP 2114).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory M. Desire whose telephone number is (571) 272-7449. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory M. Desire  
Examiner  
Art Unit 2625



*Gregory M. Desire*

G.D.  
June 20, 2005